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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,881	12/13/2001	James K. Guy	99-377/009774	4438
7590	04/13/2004		EXAMINER	
Robert P. Renke Artz & Artz, P.C. Suite 250 28333 Telegraph Road Southfield, MI 48034			MAHONEY, CHRISTOPHER E	
			ART UNIT	PAPER NUMBER
			2851	
			DATE MAILED: 04/13/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/022,881	GUY, JAMES K.
	<b>Examiner</b>	<b>Art Unit</b>
	Christopher E Mahoney	2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 November 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) \_\_\_\_\_ is/are pending in the application.

4a) Of the above claim(s) 1-5,9-13 and 17-22 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5,9-13 and 17-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Response to Arguments***

In view of the supplemental appeal brief filed on November 21, 2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The applicant argues that the pins originate from the diaphragm. This is not found in the claims. Reciting that “a first portion of at least of the .. diaphragm leaves coupled to the stator” does not mean that the pin originates from the diaphragm. It just means that it is coupled to the stator. It could be coupled to the stator via a pin originating from the stator.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters 38 and 39 have both been used to designate pins. It is understood that 39 and 41 are different sets of pins and that all pins, both 39 and 41 are subsets of pins 38.

However, figure 2 shows a pin in the upper left designated as both 38 and 39 without showing that the pin in the lower right is both pin 38 and 41.

The applicant is respectfully requested to add drawings illustrating the pin positions and the leaf positions in 2-3 different states of opening. It is unclear from the description and the drawings how the leaves of the diaphragm will rotate if the leaf is connected to both the rotor and the stator without a slot for sliding one of the pins.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5,9-13 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is unclear from the specification and drawings how the leaves will rotate. For example if a leaf is attached to both the rotor and stator through pins 39 and 41 and there is no slot for either pin to slide, it is unclear how the leaf will rotate so as to form a variable opening 20. If both the rotor and stator rotated in the same direction at the same rate the leaf would also rotate but would not result in a varied opening.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9-13, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Devenyi (US Patent 5,955,806). Devenyi discloses a torque motor having an annular, cylindrically symmetric stator and rotor. The stator 30 includes a frame and multiple annular magnet members 32 (See Figure 6). The annular magnet members comprise a plurality of magnets mounted on various portions (or annular elements) of the annular stator. (See Figure 7). The stator frame comprises an inner wall (first annular member) and an outer wall (second outer wall). The base of the stator functions as a sidewall. The rotor 22 is rotatably coupled to the annular magnet member 32 and defines a channel 68. The device of Devenyi further comprises a diaphragm coupled to the stator via pin 65 and to the rotor via pin 64. The diaphragm includes leaves 63 pivotally arranged to form an adjustable aperture concentric with the channel. Devenyi also discloses a light sensor 72, sensor electronics 76 and a motor controller (actuator) 80 for detecting the light intensity passing through the aperture. This data is then sent to the electronics and motor controller (logic) to control the iris/diaphragm via leads 26. (Column 4, lines 6-22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devenyi (US Patent 5,955,806) in view of Hoesterey (U.S. Patent No. 4,034,949) or Prince (U.S. Patent No. 4,050,085). Devenyi teaches the salient features of the claimed invention except for the fact that the iris is used in a telescope. Both Hoesterey and Prince teach that it was known to use an iris in a telescope. The applicant is directed to review col. 2, lines 50-54 of Hoesterey and col. 7, lines 46-48 of Prince. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Scruggs or Bellows for the purpose of controlling the amount of light per unit of time.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devenyi (US Patent 5,955,806) in view of Suzuki (U.S. Patent No. 4,378,146). Devenyi teaches the salient features of the claimed invention except for the fact that the iris is used in a camera. Suzuki teaches that it was known to use an iris (col. 2, line 68) in a camera (col. 3, line 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Suzuki for the purpose of controlling the amount of light per unit of time.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Devenyi (US Patent 5,955,806) in view of Scruggs (U.S. Patent No. 3,876,008) or in view of Bellows (U.S. Patent No. 4,790,194). Devenyi teaches the salient features of the claimed invention except for the fact that the iris is used in a pipe. Both Scruggs and Bellows teach that it was known to use

an iris in a pipe. The applicant is directed to review col. 3, lines 28-31 of Scruggs and col. 4, lines 4-7 of Bellows. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features taught by Scruggs or Bellows for the purpose of controlling the amount of water flow.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E Mahoney whose telephone number is (571) 272-2122. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (571)272-2112. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher E Mahoney  
Primary Examiner  
Art Unit 2851